

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte NICHOLAS KOENIG
and
CHARLES R. BERG

Appeal No. 2003-1844
Application No. 09/643,130

ON BRIEF

Before COHEN, ABRAMS, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 1 to 23, 25, 26 and 28. Claims 24 and 27, the only other claims pending in this application, have not been rejected.

We REVERSE.

BACKGROUND

The appellants' invention generally relates to a method of playing a game utilizing a plurality of sound lines which are components of a song or ensemble, each of which may be reproduced either alone or together with any number of the other sound lines (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

Claims 1 to 22 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims 23, 25, 26 and 28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,812,688¹ to Gibson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 8, mailed April 24, 2002) and the answer (Paper No. 13, mailed January 28, 2003) for the examiner's complete reasoning in support of the rejections,

¹ Issued September 22, 1998.

and to the brief (Paper No. 12, filed November 18, 2002) and reply brief (Paper No. 14, filed February 13, 2003) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied patent to Gibson, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

We will not sustain the rejection of claims 1 to 22 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is appropriate.

Furthermore, appellants may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the Court in In re Swinehart, 439 F.2d 210, 213-14, 169 USPQ 226, 228-29 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

With this as background, we now turn to the specific rejection under 35 U.S.C. § 112, second paragraph, made by the examiner. In this rejection (answer, p. 3), the examiner stated that the phrase "may be reproduced" as utilized in independent claims

1 and 12 was misdescriptive. The examiner then noted that reproducing can mean providing a copy or replacing such as to recreate and that the specification only discloses reproducing by playing sound through a speaker.

In our view, the metes and bounds of the phrase "may be reproduced" as utilized in independent claims 1 and 12 can be understood with a reasonable degree of precision and particularity as pointed out by the appellants (brief, p. 6; reply brief, pp. 1-2). Accordingly, claims 1 and 12 are not indefinite under the second paragraph of 35 U.S.C. § 112. In that regard, breadth of a limitation of a claim is not to be equated with indefiniteness. See In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971).

For the reasons set forth above, the decision of the examiner to reject claims 1 to 22 under 35 U.S.C. § 112, second paragraph, is reversed.

The anticipation rejection

We will not sustain the rejection of claims 23, 25, 26 and 28 under 35 U.S.C. § 102(b).

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Claims 23, 25, 26 and 28 under appeal are drawn to a video casino game machine comprising, inter alia, (1) memory means for electronically storing a plurality of sound lines which are components of a song or ensemble and a plurality of images, each of which is associated with a corresponding sound line; (2) speaker means for electronically emitting an audible sound; (3) video display means for electronically displaying images to a player; (4) touch screen means associated with the video display means and possessing an array of fields for enabling a player to initiate a game control command by touching a field; and (5) a microprocessor means operationally connected to the memory means, the speaker means, the video display means and the touch screen means, whereby (i) the microprocessor means is adapted to cause images stored in the memory means to be displayed by the video display means in an array corresponding to the array of fields of the touch screen means such that an image is displayed in a corresponding field, and (ii) when a player touches a field the microprocessor means is adapted to cause a sound line stored in the memory means

that corresponds with the image displayed in the touched field to be emitted by the speaker means.

Gibson's invention relates generally to the art of mixing audio source signals to create a final sound product, and more specifically, to a method and apparatus for utilizing visual images of sounds to control and mix the source signals, including any sound effects added thereto, to achieve a desired sound product. According to Gibson's invention, each audio signal is digitized and then transformed into a predefined visual image. Selected audio characteristics of the audio signal, such as frequency, amplitude, time and spatial placement, are correlated to selected visual characteristics of the visual image, such as size, location, texture, density and color, and dynamic changes or adjustment to any one of these parameters causes a corresponding change in the correlated parameter.

As shown in Figure 2 of Gibson, a microcomputer system 50 is added to a mixing system 10 (shown in Figure 1). The microcomputer system 50 includes a central processing unit (CPU) 52, a digital signal processing unit (DSP) 54, and an analog-to-digital converter (A/D) 56. Sound signals are intercepted at the inputs to the mixing console 10, then digitized, if necessary, by A/D unit 56. The output of the A/D unit 56 is then fed to the DSP unit 54 which transforms each digitized sound signal into

a visual image, which is then processed by CPU 52 and displayed on video display monitor 58. The displayed visual images may be adjusted by the user via user control 60. In a preferred embodiment, the user control 60 includes a touch sensitive display screen which permits to user to reach out and touch the visual images and manipulate them, as will now be described.

Referring now to Figure 6 of Gibson, a mix window displayed on monitor 58 shows three spheres 220a, 220b and 220c suspended within the boundaries of room 200. Any of the spheres 220a, 220b, or 220c, may be panned to any horizontal or x-position between speakers 212 and 214 by moving the image of the spheres on the monitor 58. The spheres may also be moved up and down.

The appellants argue (brief, pp. 7-8) that every element of claims 23, 25, 26 and 28 is not disclosed in Gibson. We agree. Specifically, Gibson does not disclose the claimed microprocessor means which causes a sound line stored in the memory means to be emitted by the speaker means when a player touches a field on the touch screen means that corresponds with the image displayed in the touched field as recited in claims 23, 25, 26 and 28. Moreover, Gibson does not disclose a video casino game machine. Claims 23, 25, 26 and 28 are directed to a video casino game machine and Gibson's apparatus for using visual images to mix sound is not a video casino game

machine. Contrary to the examiner's assertions, the introductory phrase of these claims (i.e., a video casino game machine) must be given weight. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use can be resolved only on review of the entirety of the patent application to gain an understanding of what the appellants actually invented and intended to encompass by the claim. See Rowe v. Dror, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Inspection of the entire record in this case reveals that "a video casino game machine" is, in fact, a structural limitation of the appellants' claims 23, 25, 26 and 28. Thus, we conclude that the introductory phrase in this instance does not merely state a purpose or intended use for the claimed structure. Rather, these words give "life and meaning" and provide further positive limitations to the invention claimed. Furthermore, the examiner's assertion (answer, p. 4) that Gibson's apparatus for using visual images to mix sound can be considered to be a video game machine is not germane to the claims at issue since they recite a video **casino** game machine.²

For the reasons set forth above, the decision of the examiner to reject claims 23, 25, 26 and 28 under 35 U.S.C. § 102(b) is reversed.

² In our view, a person of ordinary skill in the art would understand that not every game is a casino game and that to the extent Gibson discloses a video game, it would not be considered to be a video casino game.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 22 under 35 U.S.C. § 112, second paragraph, is reversed and the decision of the examiner to reject claims 23, 25, 26 and 28 under 35 U.S.C. § 102(b) is reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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